

REMARKS

Upon entry of the present Amendment, claims 1-9 and 11-13 will be pending in the Application.

Claims 1-9, 11, and 13 have been amended for proper antecedent basis and to correct certain typographical errors. No new matter has been introduced by these amendments.

Claims 1 and 13 have further been amended to recite that the at least one polyurethanepolyol (C) is free of ionic and potentially ionic groups. Support for this amendment can be found at least in the present Application as filed, page 5, line 27, to page 6, line 3. No new matter has been introduced by this amendment.

Amendments to the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments.

No claims have been added or canceled.

Applicants regret the filing of the improper RCE which resulted from an unintentional typographical error by the Undersigned. Applicants did not intend to file an RCE in the present Application.

Reconsideration is respectfully requested in view of the foregoing amendments and/or following remarks.

1. **Rejection of claims 1-9 and 11-12 under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 7,041,729 to Woltering et al., hereafter “Woltering”, in view of U.S. Patent No. 6,372,875 to Mayer et al., hereafter “Mayer”.**

Woltering discloses a pseudoplastic powder clearcoat slurry free from organic solvents and external emulsifiers and comprising particles which are solid and/or of high viscosity. The particles comprise as binder at least one polyol with an OH number >110 mg KOH/g, containing potentially ionic groups, and where the powder clearcoat slurry has a potentially ionic group content of from 0.05 to 1 meq/g of solids. (Woltering, abstract, emphasis added).

Mayer discloses a process for the preparation of polyurethane resins, in which at least one compound containing 2 groups which are reactive toward isocyanate groups, containing, at least in part, at least one group capable of forming anions which is neutralized before or after incorporation into the polyurethane molecule, is used to prepare a polyurethane resin. (Mayer, abstract, emphasis added).

Independent claim 1, as currently amended, is directed to a pseudoplastic aqueous dispersion comprising, among others, at least one solid polyurethanepolyol (C) free of ionic and potentially groups.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, or knowledge generally available in the art at the time of the invention, must provide some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1998).

Applicants respectfully submit that claims 1-9 and 11-12 are patentable over the combination Woltering and Mayer, at least because this combination does not teach or suggest all the elements of independent claim 1, as currently amended, and provides no

motivation to modify its teaching to arrive at Applicants' independent claim 1, as currently amended.

Applicants respectfully submit that Woltering and Mayer both require that the polyurethane comprises ionic and/or potentially ionic groups as discussed above. On the other hand, Applicants' independent claim 1, as currently amended, recites that the polyurethane polyol is free of ionic and potentially ionic groups. Therefore, it is respectfully asserted that any modification to Woltering, the primary reference, to exclude ionic and potentially ionic groups, would render Woltering unsuitable for its intended purpose. In this regard, the courts have held that "[i]f the proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon* 733 F. 2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The courts have also held that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." *In re Ratti* 270 F. 2d 810, 123 USPQ 349 (CCPA 1959).

In addition, Applicants respectfully submit that Woltering and Mayer, by requiring ionic and/or potentially ionic groups, teach away from Applicants' independent claim 1, as currently amended. A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997), emphasis added.

In view of the above, Applicants respectfully assert that claims 1-9 and 11-12 are patentable over the combination Woltering and Mayer under 35 U.S.C. §103(a). Withdrawal of this rejection is respectfully requested.

2. **Rejection of claim 13 under 35 U.S.C. §103(a) as allegedly unpatentable over Woltering in view of Mayer.**

Applicants respectfully assert that independent claim 13, as currently amended, is patentable over the combination of Woltering and Mayer for at least the same reasons discussed above. Withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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